

Remarks

Claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66-71 are pending and under consideration in this application. Support for the amendment can be found, *inter alia*, in paragraphs [0037], [0040] and [0048] of the specification. The amendment does not add new matter.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63 and 66-71 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (WO 95/02049) in view of Nieuwkerk *et al.* (U.S. Patent No. 5,438,128). (Office Action, page 5.) Applicants respectfully disagree but have amended claims to facilitate prosecution.

The Examiner asserts that it would have been *prima facie* obvious to improve the method of isolating nucleic acids from cell lysate by using the filter apparatus as taught by Jones to include multiple layer filter bed of filters housed within the same column as taught by Nieuwkerk (Office Action, page 6).

Applicants have amended independent claims 1, 31, 55, 67 and 71 to recite, in part, that “and said second filter layer allows said biological macromolecules to pass and said biological macromolecules are isolated.” Support for the amendments can be found, *inter alia*, at paragraphs [0037], [0040], and [0048] of the specification. The amendments do not add new matter. Applicants note that Jones passes the target molecule (e.g.: DNA) through the first filter, but NOT through the second filter. That is, Jones binds the target molecule to the second matrix (instead of passing it through like the instantly claimed invention) and it is further noted that the methods taught by Jones necessarily include an elution step. For example see page 3, fourth full paragraph of Jones. The present claims are directed, in part, to methods where biological macromolecules are isolated without an elution step. Nieuwkerk does not disclose a method where a “first filter layer retains cellular debris” so therefore does not remedy the deficiencies of Jones. Therefore, all of the elements of the present claims are not taught or suggested by the cited art and a *prima facie* case of obviousness has not been established.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. 103(a).

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,
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April 1, 2011